

REMARKS

Applicant has amended claims 1 and 9 without changing their scope. No new matter has been added.

Claims 1-17 have been rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,840,922 (Kobayashi). This rejection is respectfully traversed.

The Examiner contends on page 4 of the Action that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform and cites *In re Hutchison*, 69 USPQ 138 as support this argument. Applicant respectfully disagrees.

First, *Hutchison*, which was decided on March 6, 1946, does not provide an adequate basis for such an argument in modern day case law since it was decided prior to the enactment of the Patent Act of 1952, the current patent law.

Second, the “adapted to” expression in *Hutchison* appeared in the preambles of claims 42 and 58 at issue. Accordingly, as the court correctly stated, this expression in the preamble does not constitute a limitation. However, the “adapted to” expression of claims 1 and 9 prior to this amendment is in the body of the claims, and thus positively limits the claim scope, contrary to the Examiner’s statement above.

Third, persons skilled in this art would interpret the “adapted to” language of the claims as describing positive structural attributes of the relationship between the light emitting element and the thin film.

Applicant, however, has amended claims 1 and 9 to replace the “adapted to” expression with “configured to” to expedite prosecution without changing the intended scope of the claims. Claim 1 as amended includes the feature that the thin film disposed on the light emitting element is configured to transmit light when the thin film is irradiated with light from the light emitting element and to block light when the thin film is not irradiated

with light from the light emitting element. In other words, the thin film forms an optical aperture only when it is irradiated with light. Accordingly, the design parameters of the film, including the melting point (page 4, lines 11-17) and the film thickness (page 11, lines 2-5), must be determined with respect to other design parameters of the device such as the laser power so that the film transmits light under light irradiation and block light without light irradiation. For example, irradiation of a high power laser on a thin film could lead to destruction of the film and loss of the light blocking feature. Thus, the film of claim 1 is configured both to transmit and to block depending on the irradiation. This is not a film that merely performs only one function, for example transmitting light, in one fabricated form of the device, and performs only the other function, for example blocking light, in the other fabricated form of the device.

On the contrary, Kobayashi's device has a permanent hole in a masking layer 4 as an aperture of the device, as the Examiner admits on page 3, lines 10-12 of the Action. All of the manufacturing methods described in the examples of Kobayashi either blow the masking layer 4 out or cause it to evaporate under vacuum. Creation of a permanent aperture by high power beam radiation, as in the case of Kobayashi, is described as undesirable in the specification of this application (page 3, lines 8-16) and is intended to be avoided by this invention.

Furthermore, although the claims of Kobayashi refer to the use of a laser for making the masking film transparent, Kobayashi does not teach or suggest that the film transmit light under light irradiation and block light without light irradiation. All of the examples are devoted to the description of permanent holes. In the absence of any specific disclosure about the optical properties of the transparent film, persons of ordinary skill in the art would have recognized that the formation of the transparent masking film is also irreversible, and

that the transparent portion of the masking film is a permanent aperture which cannot block light even when it is not irradiated with light.

The masking layer of Kobayashi is not configured to provide the feature of claim 1, i.e., transmit light during light irradiation and block light without light irradiation. Accordingly, Kobayashi does not teach or suggest the film feature of claim 1.

Claim 9 also recites the similar feature that the thin film disposed on the light emitting element is configured to transmit light when the thin film is heated and to block light when the thin film is not heated. Kobayashi does not teach or suggest this feature either. Thus, the rejection of claims 1-17 should be withdrawn.

Furthermore, claims 1 and 9 have been amended only to avoid a prolonged argument with the Examiner on the specific claim language without changing the scope of claims 1 and 9.

In light of the above, a Notice of Allowance is solicited.

Attached hereto is a marked-up version of the changes made to the claims by this amendment, captioned "**Version with markings to show changes made**".

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing Docket No. **325772017700**.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. (Twice Amended) A near field light generating device, comprising:
a light emitting element that emits light from its exit surface; and
a thin film disposed on the exit surface,
wherein the thin film is [adapted for transmitting] configured to transmit light when
the thin film is irradiated with light from said light emitting element and [for blocking] to
block light when the thin film is not irradiated with light from said light emitting element.
9. (Twice Amended) A near field light generating device, comprising:
a light emitting element that emits light from its exit surface; and
a thin film disposed on the exit surface,
wherein the thin film is [adapted] configured to transmit light when the thin film is
heated and to block light when the thin film is not heated.